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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,585	05/16/2001	Henry V. Izzo	2280.2720	1418
5514	7590	01/31/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			JANVIER, JEAN D	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			3622	
DATE MAILED: 01/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

09/855,585

Applicant(s)

IZZO ET AL.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/12/06 has been entered. And a Non-Final Office Action follows.

Response To Applicant's Amendments

The Examiner approves the new title of the invention and the amendments made to the claims. Further, although the Examiner could have made the present action final since the changes made to the claims do not overcome the prior art, however, in the interest of "good customer service", the Examiner herein issues a Non-Final Office Action.

DETAILED ACTION

Claim Status

Claims 1-24 are currently pending in the Instant Application.

Specification

Claim Objections

Claims 1, 8, 13 and 18 are objected to because of the following informalities-

Concerning claims 1, 8, 13 and 18, "...an item of a plurality of items" should apparently be - -an item from a plurality of items--.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 8, 13 and 18 (including their dependent claims) recite the limitation "of a same type". Here, "of a same type" renders the claims indefinite since it is unclear what the Applicant means by "same type" or whether or not "same type" indicates - -products of the same color--, --products of same shape--, etc. For examination purpose, the claims will be broadly interpreted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker, US Patent 6, 443, 843B1.

As per claims 1-24, Walker discloses a method of and a system for providing a product to a user or consumer during an online (Internet) or offline transaction, wherein a selection of a **(promotional)** product, having a specific identification code or UPC code or identifier, is received from a customer or user including a signal or an indication (or a fee) to play a game (or to participate in a sweepstakes game). An outcome of the game, associated with the (promotional) product identification code, is determined. And if the outcome is a winning outcome, then the product is provided to the customer at no charge (the winning prize is the **promotional** product bought by the consumer) or if the outcome is a losing outcome, then the fee (paid for the entry) or a portion of it is applied to the or used to reduce the price of the **uniquely** purchased product itself. Here, the steps of selecting by a user a product having an identification code (providing a product to the consumer...), receiving an input from the consumer indicating his intention to participate in a game, related to the product identification

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code, for a prize (enabling the consumer to input the identification code into a prize redemption system and validating the identification code....) and determining whether the identification code is a winning code (determining the game outcome) are implicitly or explicitly supported in the current reference (See abstract; figs. 10 and 11).

Walker discloses, in general, that the customer receives the identified product for free if the outcome of the game is a winning outcome or the customer is credited the entire received fee, associated with the game entry, if the outcome is a losing outcome (or the entry fee or a portion of it may be applied or used to reduce the sales price of the identified product). This increases the attractiveness of the system to customers because a participating customer will either win the product (as a prize if the outcome of the game, related to the identified code, is a winning outcome) or be no worse off than if the game was not played in the first time. Accordingly, a retailer may be willing to practice this embodiment in return for increased customer traffic and customer loyalty (col. 2: 10-62).

See col. 3: 41 to col. 4: 32

Initially, in step S810 of fig. 8, a selection of a product is received from a customer. For example, in an embodiment in which the customer is physically present in a retail store, the selection is received when a customer uses a customer device, such as an in-store kiosk, a PDA or other hand-held device (including, but not limited to, a cellular telephone) in communication with the retailer controller 100 of fig. 2 via the World Wide Web or another type of network, to locate and request information regarding a **(promotional)** product. A selection may also be received once the customer uses a customer device to indicate an intent to purchase a product by

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adding the product to a virtual "shopping cart", or once a desired product is identified by a POS terminal during customer checkout procedures, in fig. 11.

In an online (Internet) embodiment of step S810, a customer's initial request to access a home page of a website operated by a retailer or an indication that a web page describing the product has been viewed for a particular period of time may each be considered a selection of a product. Of course, selection of a picture or a description of a product, having an identification code, displayed on a web page of the website, addition of a product into a virtual shopping cart, or an indication of a desire to purchase a product may each be considered a received selection of a product in step S810 of fig. 8 and wherein, with the selection of an identified product, the customer can participate in a game (slot machine type-game) for a chance to obtain or acquire the identified product for free if the outcome of the game is a winning outcome.

The product selected in step S810 may be selected from among all products offered by a retailer or from among a particular set of products identified by the retailer. **Determination of the particular set of products may be based on a purchasing history of the customer, on purchasing histories of all customers, on inventory, or on other revenue management information.**

Additionally, a request to play a game, as mentioned above, for the selected product is received in step S820 of fig. 8. The request may be received from the customer device 200, such as a PDA (or other hand held device including a cell telephone) or a dedicated kiosk providing game functionality accordingly. A selection of a product, having an identification code, received in step S810 may be considered a request to play a game in step S820. In some

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embodiments, only those customers meeting an eligibility standard, such as a minimum customer rating 550, are eligible to play a game for products according to the invention. Therefore, step S820 may also include determination of whether the customer from whom the request was received meets the eligibility standard. The customers may also be part of a loyalty program and use identification card such as a shopper's card to participate in the promotional game (the customers may be new customers as well).

Further, the game, which will be played for the selected and identified product itself is defined. In one embodiment, the type of game is initially determined based on a **selection by a customer of one of several games, or determined from among the several games based on other criteria**. These criteria may include a number of winning outcomes and a probability of each winning outcome reflected by each of the several games. The type of game may also be predetermined. In some embodiments, the type of game determined in step S830 is a game for which a probability of a winning outcome is controllable or known, such as a slot machine game or a lottery-type game (virtual hat).

Finally, in one embodiment of step S830 of fig. 8, the selected or chosen game results in a winning outcome if the retailer controller 100 of fig. 2 **randomly selects a single white ball from a bin of black balls (random selection or random number generator)**. The bin may be a real bin or an electronic representation of a bin.

See col. 12: 65 to col. 14: 30; col. 14: 62-66; figs. 10 and 11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-7, 8, 10-12, 13, 15-17, 18, 20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lieberman, US Patent 5, 585, 369A.

As per claims 1, 3, 5-7, 8, 10-12, 13, 15-17, 18, 20 and 22-24, Lieberman discloses a method of and a system for enabling a user to enter data including a promotional product code on an entry form to thereby participate in a prize drawing game of chance (**enabling a participant to input, inter alia, an identification code related to a specific product produced or manufactured by a manufacturer into an entry form to thereby participate in a drawing or prize redemption system**). To this end, entry forms are provided, which depict and advertise the product, which the game promotes, and which include spaces for the entrant or user to write self-identifying information. The entry forms also include a laser-scannable bar code, which uniquely identifies the product being promoted. The inclusion of this bar code facilitates automated sorting of entry forms and makes practical the processing of a plurality of games, each promoting a different product, simultaneously within a single, centralized processing facility. The entry forms also include spaces in which the entrant is required to write the universal product-code number (UPC) or identification code, which uniquely identifies the product being promoted by the game. Since this number is not disclosed on the printed entry form, used by the entrant to

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participate, and since the most convenient source of the number is the label of the product that is being promoted, then the handwritten-UPC-number requirement (the UPC code must be entered or written down on the entry form by the user) gives consumers an incentive to seek out, view and handle the product which is the subject of the promotion.

According to the present system, written entry forms may be made available to potential participants or entrants in one or more of numerous different, alternative ways, including, for example, the following: (1) As clippable coupons distributed in newspapers, mailers, flyers, or the like; (2) as tearable coupons mounted on or in a conventional poster, card dispenser, coupon dispenser (kiosk), or the like; (3) as part of an automated teller machine (ATM) receipt and so on and so forth.

See abstract; col. 3: 15 to col. 5: 10; col. 5: 49 to col. 6: 12.

Response To Applicant's Arguments

First, the Applicant's arguments are directed to the newly amended claims and thus, the Applicant's remarks are fully addressed above.

Second, Applicant argues that Walker does teach providing a product, the label of which bears an ID code, enabling the consumer to input the ID code and determining whether the consumer is entitled to receive a prize on the basis of the ID code. Applicant further argues that it would not be possible to use a conventional UPC code, as taught by Walker, as an ID code since a UPC code identifies a product and since the same UPC code is typically used across multiple units of the same product. The Examiner completely and respectfully disagrees with the

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Applicant's findings. Indeed, Walker discloses a method of and a system for providing a product to a user or consumer during an online (Internet) or offline transaction, wherein a selection of a **(promotional)** product, having a specific identification code or UPC code or identifier, is received from a customer or user including a signal or an indication (or a fee) to play a game (or to participate in a sweepstakes game). An outcome of the game, associated with the (promotional) product identification code, is determined. And if the outcome is a winning outcome, then the product is provided to the customer at no charge (the winning prize is the **promotional** product bought by the consumer) or if the outcome is a losing outcome, then the fee (paid for the entry) or a portion of it is applied to the or used to reduce the price of the **uniquely** purchased product itself. Here, the steps of selecting by a user a product having an identification code (providing a product to the consumer...), receiving an input from the consumer indicating his intention to participate in a game, related to the product identification code, for a prize (enabling the consumer to input the identification code into a prize redemption system and validating the identification code....) and determining whether the identification code is a winning code (determining the game outcome) are implicitly or explicitly supported in the current reference (See abstract; figs. 10 and 11). In short, Walker discloses a system, wherein a selection of a (promotional) product, having an identification code or identifier, received in step S810 may be considered a request to play a game in step 325411111*S820 of fig. 8 and the system is configured to determine whether a "win" outcome 730 of fig. 7 is associated with the received product identifier, as represented in a retrieved outcome information (col. 20: 42-45).

Third, contrary to the Applicant's conclusion, a UPC code or identifier associated with a product uniquely identifies the product from a particular manufacturer. For example, a typical

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UPC code, in the form of a bar code and human readable code or number, has at least two fields A and B comprising five digits each. The first field A represents the manufacturer of a product and the second field uniquely identifies the product related to the manufacturer. This aspect is very well documented in the art.

Finally, Applicant's arguments with respect to Walker's and Lieberman's are not plausible.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,898,153AA to Lagan discloses a method for automatically processing sweepstakes entries and mail orders is disclosed. The method reads a machine code identifying the sender and simultaneously detects orders from non-orders using a magnetic field detector, without opening the envelopes. The machine code is printed on the outside face of the envelope, or alternatively, on the reply insert itself, in which case it is visible through a die-cut window formed in the return envelope. When read, the machine code identifies the contestant and enters him or her into the sweepstakes. The returned envelopes are also fed through a sorter which magnetically detects whether each return envelope contains a magnetic order stamp. If the sorter detects a magnetic stamp, the envelope is routed to an order batch where the envelope is opened for order processing, otherwise the envelope is routed to a non-order batch. During the outgoing mail

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processing, a machine code indicative of the recipient may be preprinted on each carrier envelope or reply insert. This code may be read and used to print a machine code corresponding thereto on the return envelope. The return envelope and the reply insert, along with order stamps each having a magnetic ink layer, are inserted into the carrier envelope and mailed out to the recipient (See abstract).

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft (effective on 7/15/05).

01/22/06

JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

